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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,637	07/28/2000	Kenichi Oinoue	P/3541-6	2855

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OSTROLENK FABER GERB & SOFFEN LLP  
1180 Avenue of the Americas  
New York, NY 10036-8403

EXAMINER

GENCO, BRIAN C

ART UNIT PAPER NUMBER

2615

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/627,637

**Applicant(s)**

OINOUE, KENICHI

**Examiner**

Brian C Genco

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on January 10, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9, 10 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 8, 2004 has been entered.

Applicant's arguments filed October 8, 2004 and February 17, 2005 have been fully considered but they are not persuasive.

Examiner thanks Applicant for the addition of Fig. 4. However, while showing the teaching disclosed on page 17, lines 20-22 this figure does not shown the limitation of decreasing the set memory capacity when it is judged that it is impossible to transmit the recorded information. As such, this drawing objection still stands.

Applicant has argued that claims 9 and 10 were supported in the specification through the citation of page 17, lines 20-22 and page 15, lines 18-22 and step S08 of Fig. 3.

In response, as noted in the advisory action mailed on November 15, 2004 the citation of page 17, lines 20-22 discloses that a user may set the memory capacity threshold. This section does not disclose the setting means resets the set memory capacity when said judgment means judges that it is impossible to transmit the record information. Applicant has further cited page 15, lines 18-22 for support, however this section is describing the amount of data to be transmitted per unit time, namely reducing the bandwidth of the transmission when the signal is

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weak. This does not disclose the setting means resets the set memory capacity when said judgment means judges that it is impossible to transmit the record information. Examiner notes that claim 16 was restricted for claiming limitations similar to that described in the above cited section.

Upon further consideration of the specification Examiner notes page 17, lines 11-16 wherein it is disclosed that, "It is desirable the value to judge whether the above-mentioned transfer is performed or not can be freely and variably set according to ... the radio environment of the use place". Examiner notes that according to this disclosure in conjunction with the early citation of page 15, lines 18-22 it appears that there is support in the specification that memory capacity can be decreased according to a decreased electric field intensity. Examiner notes the general example on page 13, lines 5-9 wherein if the total capacity of a memory card is 8 MB then the predetermined value is set to 6 MB. Based on the passages cited above, the specification appears to teach that under that example, if the electric field intensity was low then the predetermined value would be decreased to, for example, 4 MB. As would be recognized by one skilled in the art, this allows for the extra time needed to transfer the image data since the transmission rate is decreased when the electric field intensity is low as discussed on page 15, lines 18-26.

However, there does not seem to be any support for decreasing the set memory capacity upon judging that it is impossible to transmit the recorded information.

### *Drawings*

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The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the setting means decreasing the set memory capacity when said judgment means judges that it is impossible to transmit the recorded information must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following:

Examiner can find no description in the specification for originally presented Claims 9, 10 and 17-20, namely, "said setting means decreases the set memory capacity when said judgment means judges that it is impossible to transmit the record information" or "said setting means resets the set memory capacity when said judgment means judges that it is impossible to transmit the record information." Examiner notes that as described in the disclosure on page 15, lines 9-13 and again on page 16, line 5-8 that when it is impossible to transmit the recorded information that the process is ended and returned to step S01 of Fig. 3. There also does not appear to be any description of resetting the capacity when it is impossible to transmit the record information.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

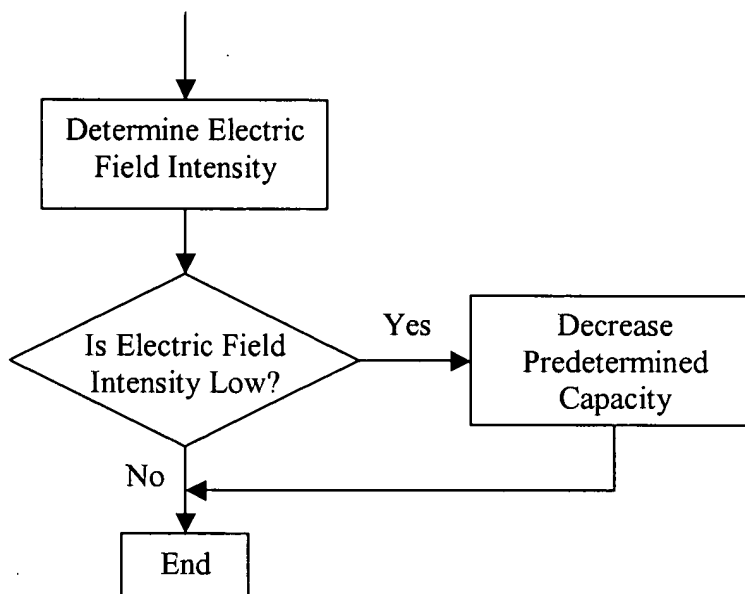
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 10, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for decreasing the set memory capacity when it is judged that the electric field intensity is low, does not reasonably provide enablement for decreasing the set memory capacity when it is judged that it is impossible to transmit the recorded information. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

In order to overcome this rejection the Examiner suggests amending claim 9 to read “said transmission control means includes judgment means to judge the capability of transmitting the recorded information to a nearest communication base station, and said setting means decreases the set memory capacity when said judgment means judges that there is a low capability to transmit the recorded information.” Examiner suggests similar amendments to claims 10 and 17-20.

Should Applicant adopt Examiner’s suggestions with regards to the claims, the Examiner further suggests that the Applicant add a further figure so as to show the limitations above. The Examiner suggests submitting a flow chart similar to the one illustrated bellow.

Start



### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian C. Genco who can be reached by phone at 571-272-7364 or by fax at 571-273-7364. The examiner can normally be reached on Monday thru Friday 8:30am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached at 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 571-272-2600.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian C Genco  
Examiner  
Art Unit 2615

March 29, 2005



TUAN HO  
PRIMARY EXAMINER